



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,319	11/22/1999	MICHAEL ADRIAN GOOCH	11129/2	3669

26646 7590 03/17/2004

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

KAZIMI, HANI M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,319

Applicant(s)

GOOCH, MICHAEL ADRIAN

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 22, 25 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 22, 25 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's Request for Continued Examination (RCE) and reconsideration filed on December 19, 2003. The rejections cited are as stated below:

Status of Claims

2. Of the original claims 1-18, claims 1, 16, 17, and 18 have been amended, and claims 19-30 have been added in the amendment filed on April 29, 2003. In the amendment filed on December 19, 2003, claims 20, 21, 23, 24, 26, 27, 29, and 30 have been canceled without prejudice, claims 1, and 16-18 have been amended. Therefore, claims 1-19, 22, 25, and 28 are under prosecution in this application.

Response to Applicant's Amendment

3. Applicants' arguments filed on December 19, 2003 have been fully considered, and discussed in the next section below or within the following rejections are not deemed to be persuasive, and Applicants' request for allowance is respectfully denied.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3624

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

6. Claims 1-9, 11-19, 22, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popolo, U.S. patent 5,715,402 in view of BoxLot Online Auction, "review auction & bidding formats", hereinafter "BoxLot", as discussed in paragraph 6 of paper No. 7.

Further: Claims 1-9, 11-19, 22, 25, and 28, Popolo teaches that the best price response is a highest one of the at least one response received from the users, and the users are able to adjust or cancel a corresponding response at any time before the customer accepts the best price response (column 11, line 1 thru column 14, line 44).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popolo, U.S. patent 5,715,402 in view of BoxLot Online Auction, "review auction & bidding formats", hereinafter "BoxLot", and further in view of Kalmus et al, U.S. patent 4,674,044 as discussed in paragraph 7 of paper No. 7.

Response to Arguments

8. In the remarks, the Applicant argues in substance that;

a) "The Examiner relies on an asserted "download date" of "September 22, 1999". It is respectfully requested that the Examiner identify how this information was obtained and the source of the download date since it appears nowhere on the copy cited. It is respectfully requested that the Office provide sufficient information to verify the accuracy of this presently unverifiable information as to the "BoxLot" reference."

b) The Popolo reference does not describe or suggest that the "users, taking into account whether the first indication or the second indication is provided, are able to adjust or cancel a corresponding response at any time before the customer accepts the best price response", and that the "best price response is a highest one of the at least one response received from the users".

c) There would be no motivation (and none has been provided) to combine the subject matter of the primary Popolo reference, which refers to a non-proxy spot metal seller/buyer matching system with the "proxy" bidding system of the secondary "BoxLot" reference. There is no evidence, except subjective speculation, for combining or modifying the references relied upon to provide the features and benefits of any of the rejected claims

d) In "BoxLot", there is no best price response that is a highest one of the price responses received from the users, and so that the users are not able to adjust or cancel a corresponding response at any time before the customer accepts the price response. This is because the seller apparently has no control over accepting the bid in real time, since the reference only indicates that the buyer and seller are notified when there is a winning bid.

Art Unit: 3624

; In response to a);

This download date of September 22, 1999 is printed on the bottom of pages 1, and 4 of the reference with a down load time of 8:31 AM, the source is on the top of each page of the reference (<http://www.boxlot.com/formats.html>). If this article is not on the web site any longer, chances are the web site has been updated, this article was down loaded more than 4 years ago. The source and date of down load information are printed on the reference itself, if Applicant's copy does not have this information, the Examiner will provide a copy of the reference that is in the file.

In response to b);

Popolo reference clearly teaches that the users are able to adjust or cancel a corresponding response at any time before the customer accepts the best price response, and the best price response is a highest one of the at least one response received from the users (see rejection above).

In response to c);

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Popolo does fail to teach the use of proxy bidding. However, an auction system that receives bids from customers can easily be modified to include proxy bidding. Furthermore, in the previous office action the Examiner provided a motivation to combine, and supported the

Art Unit: 3624

motivation to combine by evidence from the BoxLot reference itself by showing the advantages of providing the customers with these type of notifications. (see paragraph 6, of paper No. 7).

In response to d);

BoxLot was not relied upon in rejecting this feature, see rejection above with respect to claims 1-9, 11-19, 22, 25, and 28.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

March 8, 2004